

Practitioner's Docket No. NEB-228**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Richard D. Morgan, et al.

Application No.: 10 /616,689

Group No.:

Filed: July 10, 2003

Examiner:

For: A Novel Type II Restriction Endonuclease, CstMI, Obtainable

From *Corynebacterium striatum* M82B And A Process For Producing The Same

Commissioner for Patents

Washington, D.C. 20231

**AMENDMENT, REQUEST AND FEE TO DELETE AND/OR
ADD TO ORIGINAL ERRONEOUSLY NAMED OR NOT NAMED
INVENTOR(S) IN—NONPROVISIONAL APPLICATION—DECLARATION
(37 C.F.R. § 1.48(a))**

NOTE: "If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention of the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors." 37 C.F.R. § 1.48(a)

NOTE: 37 C.F.R. § 1.48(f)(1): "Nonprovisional application-filing executed oath/declaration corrects inventorship. If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 naming an inventive entity different from the inventive entity set forth in the international stage."

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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☒ deposited with the United States Postal Service in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231

37 C.F.R. § 1.8(a)

☐ with sufficient postage as first class mail.

37 C.F.R. § 1.10*

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☐ facsimile transmitted to the Patent and Trademark Office, (703) _____

Date: 8/20/03

Signature

Melissa A. Jackson

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Amendment, Request and Fee to Delete and/or Add to Original Erroneously Named or Not Named Inventor(s)
in—Nonprovisional Application—Declaration (37 C.F.R. § 1.48(a)) [9-22]—page 1 of 3)

1. This amendment and request is to correct the incorrect original naming of inventor(s) in the declaration under 37 C.F.R. § 1.48(a) as set forth and filed on 7/10/03 (date).

2. Addition and/or Deletion of Inventor(s)

(check and complete all applicable items)

☒ Add the following previously unnamed person(s) as inventor(s) of this application:

Tanya Bhatia

☒ Delete the following previously incorrectly named inventor(s)

Paul Walsh

3. Attachments

Attached is

(a) A statement from: (check items below that apply)

☐ each person being added as an inventor that the error in inventorship occurred without deceptive intention on his or her part. 37 C.F.R. § 1.48(a)(1).

☐ each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part. 37 C.F.R. § 1.48(a)(1).

XXX (b) a declaration by each of the actual inventor(s) as required by 37 C.F.R. § 1.63 (or as permitted by §§ 1.42, 1.43, OR 1.47). 37 C.F.R. § 1.48(a)(2).

(c) written assent of the assignee (if any of the original inventors executed an assignment) 37 C.F.R. 1.48(a)(4)

(d) (check the following item, if all the inventor(s) remaining after this petition and amendment is accepted are not the inventor(s) of the subject matter of all the claim(s) now being claimed.)

☐ Attached is an explanation of the facts, including the ownership of all the claim(s) being claimed in this application, including the ownership of all the claim(s) at the time the last claimed invention was made (Declaration of Inventorship and Common Ownership of Claims in Application).

4. Fee Payment (37 C.F.R. § 1.17(i)–\$130.00)

The fee required is paid as follows:

☒ Attached is a ☒ check ☐ money order in the amount of \$ 130.00

☐ Authorization is hereby made to charge the amount of \$ _____

☐ to Deposit Account No. _____

☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should not be included on this form as it may become public.

☐ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

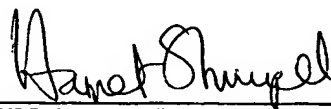
A duplicate of this paper is attached.

(Amendment, Request and Fee to Delete and/or Add to Original Erroneously Named or Not Named Inventor(s) in—Nonprovisional Application—Declaration (37 C.F.R. § 1.48(a)) [9-22]—page 2 of 3)

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Tel. No.: (978) 927-5054 X:373

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SIGNATURE OF PRACTITIONER

Harriet M. Strimpel

Patent Counsel

(type or print name of practitioner)

New England Biolabs, Inc.

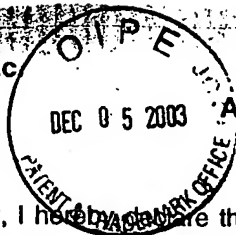
32 Tozer Road

P.O. Address

Beverly, MA 01915

(Amendment, Request and Fee to Delete and/or Add to Original Erroneously Named or Not Named Inventor(s)
in—Nonprovisional Application—Declaration (37 C.F.R. § 1.48(a)) [9-22]—page 3 of 3)

New England Biolabs, Inc.
32 Tozer Road
Beverly, MA 01915



**DECLARATION
AND POWER OF ATTORNEY
Original Application**

Attorney Docket No. NEB-228

As a below named inventor, I hereby declare that:

My residence, post address and citizenship are as stated below next to my name

I believe that I am the original, first and sole inventor (in only one name is listed at 201 below) or an original, first and joint inventor (if plural names are listed at 201-203 below) of the subject matter which is claimed and which a patent is sought on the invention entitled:

A NOVEL TYPE II RESTRICTION ENDONUCLEASE, CstMI, OBTAINABLE FROM
Corynebacterium striatum M82B AND A PROCESS FOR PRODUCING THE SAME

which is described and claimed in:

[] the attached specification or [X] the specification in Application Serial No. 10/616,689 filed 7/10/03
(for declaration not accompanying application)

And was amended on _____
if applicable

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendments referred to above. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a). I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

| FOREIGN APPLICATION(S) IF ANY, FILED WITHIN 12 MONTHS PRIOR TO THE FILING DATE OF THIS APPLICATION | | | |
|---|-------------|--------------------------------------|---|
| COUNTRY | APPLICATION | DATE OF FILING (day, month, year) | PRIORITY CLAIMED UNDER 35 U.S.C. 119 |
| | | | YES NO |
| | | | YES NO |
| ALL FOREIGN APPLICATION(S) IF ANY, FILED MORE THAN 12 MONTHS PRIOR TO THE FILING DATE OF THIS APPLICATION | | | |
| COUNTRY | APPLICATION | (day, month, year) | PRIORITY CLAIMED UNDER 35 U.S.C. 119 |
| | | | |
| | | | |

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

| Application Serial No. | Filing Date | Status (Patented, Pending, Abandoned) |
|------------------------|-------------|---------------------------------------|
| | | |
| | | |
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| | | |

DECLARATION
AND POWER OF ATTORNEY
PAGE 2 OF 3

POWER OF ATTORNEY:

As a named inventor, I hereby appoint the following attorney with full powers of association, substitution and revocation to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Gregory D. Williams

(Registration No. 30901)

Harriet M. Strimpel

(Registration No. 37008)

SEND CORRESPONDENCE TO:

Gregory D. Williams

General Counsel

New England Biolabs, Inc.

32 Tozer Road

Beverly, MA 01915

DIRECT TELEPHONE CALLS TO:

Harriet M. Strimpel

Patent Counsel

New England Biolabs, Inc.

Tele: (978) 927-5054; Ext. 373

Fax: (978) 927-1705

| | | | | |
|---|-------------------------|--|--|-------------------|
| 2 | Full Name of Inventor | Last Name Morgan | First Name Richard | Middle Name D. |
| 0 | Residence & Citizenship | City Middleton | State/Foreign Country Massachusetts | Citizenship US |
| 1 | Post Office Address | Post Office Address 31 Donovan's Way | City/State/Country Middleton, MA | Zip Code 01949 |
| 2 | Full Name of Inventor | Last Name Bhatia | First Name Tanya | Middle Name |
| 0 | Residence & Citizenship | City Peabody | State/Foreign Country Massachusetts | Citizenship US |
| 2 | Post Office Address | Post Office Address 504 Pinebrook Drive | City/State/Country Peabody, MA | Zip Code 01960 |
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 3 | Post Office Address | Post Office Address | City/State/Country | Zip Code |
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 4 | Post Office Address | Post Office Address | City/State/Country | Zip Code |
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 5 | Post Office Address | Post Office Address | City/State/Country | Zip Code |

DECLARATION
AND POWER OF ATTORNEY
PAGE 3 OF 3

| | | | | |
|---|-------------------------|---------------------|-----------------------|-------------|
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 6 | Post Office Address | Post Office Address | City/State/Country | Zip Code |
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 7 | Post Office Address | Post Office Address | City/State/Country | Zip Code |
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 8 | Post Office Address | Post Office Address | City/State/Country | Zip Code |
| 2 | Full Name of Inventor | Last Name | First Name | Middle Name |
| 0 | Residence & Citizenship | City | State/Foreign Country | Citizenship |
| 9 | Post Office Address | Post Office Address | City/State/Country | Zip Code |

I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

| | |
|---------------------------|-------------|
| Signature of Inventor 201 | Date |
| <i>[Signature]</i> | 6 August 03 |
| Signature of Inventor 202 | Date |
| <i>Tanya K Bhunia</i> | 8/5/03 |
| Signature of Inventor 203 | Date |
| Signature of Inventor 204 | Date |
| Signature of Inventor 205 | Date |
| Signature of Inventor 206 | Date |
| Signature of Inventor 207 | Date |
| Signature of Inventor 208 | Date |
| Signature of Inventor 209 | Date |